

Attorney Docket No.: DEX-0283  
Inventors: Salceda et al.  
Serial No.: 10/001,870  
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#### REMARKS

Claims 1-17 are pending in the instant application. Claim 6, 11-14, 16 and 17 have been withdrawn from consideration by the Examiner and subsequently canceled without prejudice by Applicants in this amendment. Claims 1-5, 7-9 and 15 have been rejected. Claim 1 has been amended. Claim 3 has been canceled. New claims 18 through 21 have been added. Support for these amendments can be found in the specification at page 14, line 17 through page 16, line 30, page 33, lines 3 through 5, in the mapping table provided at page 116-118 and in the Sequence Listing. Thus, no new matter is added by this amendment.

#### I. Change of Attorney Address

Applicants are submitting herewith a second request for Change of Attorney or Agent Address. It is respectfully requested that all further correspondence in this case be sent to

Kathleen A. Tyrrell  
Licata & Tyrrell P.C.  
66 East Main Street  
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in accordance with this request.

#### II. Finality of Restriction Requirement

The Examiner has made final the Restriction Requirement mailed September 22, 2003. Thus, the Examiner has withdrawn from

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consideration claims 6, 10-14, 16 and 17 and nucleic acid sequences other than SEQ ID NO:68. Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have canceled without prejudice non-elected claims 6, 10-14, 16 and 17. Further, Applicants have amended the claims to be drawn to the elected sequence SEQ ID NO:68 and its parent sequence (as taught at page 117, lines 37-38) SEQ ID NO:67. In light of the finality of this Restriction Requirement, Applicants reserve the right to file a divisional application to the canceled subject matter.

### III. Objection to Disclosure and Amendments to Specification

The disclosure has been objected to for inclusion of embedded hyperlinks. Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended the specification to inactivate any hyperlinks or other forms of browser executable code.

Further, Applicants have amended these paragraphs to correct several inadvertent typographical errors noted upon amendment to inactivate the hyperlinks.

No new matter has been added by these amendments. Withdrawal of this objection and entry of these amendments is respectfully requested.

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IV. Rejection of Claims 1-5, 7-9 and 15 under 35 U.S.C. § 112,  
second paragraph

Claims 1-5, 7-9, and 15 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Examiner regards as the invention.

Specifically, the Examiner suggests that the claims are vague and indefinite for claiming more than was elected.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have amended the claims to be drawn to the elected SEQ ID NO:68 and its parent sequence, SEQ ID NO:67. Evidence of SEQ ID NO:67 being the parent sequence of SEQ ID NO:68 is provided at page 117, line 37-38 of the instant specification.

Further, the Examiner suggests that recitation of "selectively hybridizes" in claim 1 is vague, indefinite and incomplete because the term is a relative term one and no frame of reference is given.

Applicants respectfully disagree since what is meant by "selectively hybridizes" is described in detail in the specification at page 14, lines 9-16. However, in an earnest effort to advance the prosecution of this case, Applicants have

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amended claim 1 to delete this phrase and to clarify that the nucleic acid molecule hybridizes under stringent conditions. Further, Applicants have defined these conditions in accordance with teachings at page 14, line 17, through page 16, line 30.

The Examiner also suggests that recitation of "means for determining the presence of the nucleic acid molecule of claim 1" in claim 15 is vague and indefinite because such means are not clearly defined.

Applicants respectfully disagree.

Exemplary means contemplated for determining the presence of a nucleic acid sequence are described in the patent application at page 95, line 10, through page 96, line 9.

MPEP § 2173 is quite clear; definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in that pertinent art at the time the invention was made. The content of the application in this case makes clear what is meant by stringent hybridization conditions and sets forth various means for detecting a nucleic acid in accordance with the claimed kits, thus meeting the

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requirements of 35 U.S.C. § 112, second paragraph. Further clarification in the claims is not required.

Withdrawal of these rejections under 35 U.S.C. § 112, second paragraph is respectfully requested in light of the above remarks and the amendments to the claims.

V. Rejection of Claims 1-5, 7-9 and 15 under 35 U.S.C. § 112, first paragraph - Written Description

Claims 1-5, 7-9 and 15 have been rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

In particular, the Examiner suggest that part (c) of claim 1, drawn to nucleic acids which selectively hybridize to SEQ ID NO:68 and part (d) of claim 1, drawn to nucleic acids having at least 60% identity to said sequence cover a large genus of related nucleic acids which are not described and were not in applicants possession.

In addition, the Examiner has rejected claim 3 suggesting that the specification fails to describe the complete genomic DNA sequence corresponding to the cDNA of SEQ ID NO:68.

Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have canceled claim 3.

Applicants respectfully disagree with the Examiner's

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suggestion that the specification does not meet the written description requirements with respect to claim 1, part (c) and (d).

At the outset, it is respectfully pointed out that parts (c) and (d) have been amended and are now drawn to a nucleic acid sequence hybridizing under stringent hybridization conditions of 50% formamide/6X SSC at 42°C for at least 10 hours or 6X SSC at 68°C without formamide for at least 10 hours to the nucleic acid molecule of (a) or (b) or a nucleic acid molecule having at least 90% sequence identity to the nucleic acid molecule of (a) or (b). Support for these amendments are provided in the specification at page 14, line 17 through page 16, line 30, and page 33, lines 3 through 5. Detailed methodologies for ascertaining sequences which meet these structural limitations of the instant amended claims are set forth in the specification at page 13, lines 2-22, and page 14, line 16 through page 16, line 30. Further methods for assessing percent sequence identity and/or the ability of a nucleic acid sequence to hybridize under stringent conditions to a disclosed reference sequence are performed routinely by those skilled in the art. Thus, upon discovery of the instant claimed nucleic acid sequence of SEQ ID NO:68 and its parent sequence SEQ ID NO:67, applicants were clearly in possession of additional

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nucleic acid sequences identified in accordance with routine procedures based upon this reference sequence. Further, the instant specification and its teachings clearly place the public in possession of these sequences as well.

Thus, the instant specification and the claims as amended meet the "essential goal" of the written description requirements of 35 U.S.C. § 112, first paragraph as set forth in MPEP § 2163.

Withdrawal of this rejection under 35 U.S.C. § 112, first paragraph, is therefore respectfully requested.

VI. Rejection of Claims 1-5, 7-9 and 15 under 35 U.S.C. § 101 and 112, first paragraph

Claim 1-5, 7-9 and 15 have been rejected under 35 U.S.C. § 101 because the Examiner suggests that the claimed invention lacks patentable utility. The claims have also been rejected under 35 U.S.C. § 112, first paragraph as the Examiner suggests that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the Examiner suggests that the data presented in the case does not show a nexus between the presence or expression of SEQ ID NO:68 and prostate cancer.

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Applicants respectfully traverse these rejections.

The instant application claims the benefit of priority from U.S. Provisional Application Serial No. 60/252,189, filed November 21, 2000, the entire contents of which were incorporated by reference in their entirety into the instant application. See page 1, lines 4-6 of the instant application. In the priority application, parent sequence SEQ ID NO:67, referred to therein as SEQ ID NO:58 (see page 117, lines 37-38 of the instant application), was demonstrated by suppression subtractive hybridization to be a prostate cancer specific marker. These experiments described at pages 26 through 28 of the provisional application, which demonstrate utility of the instant claimed invention, have been incorporated into the instant application as Example 1a at page 119. No new matter is added by this amendment.

The case law on utility is quite clear; mere identification of a pharmacological activity of a claimed compound that is relevant to an asserted pharmacological use provides an immediate benefit to the public and thus satisfies the utility requirement. *Nelson v. Bowler*, 626 F.2d 853, 206 USPQ 881, 883 (CCPA 1980). Clearly identification of SEQ ID NO:67, the parent sequence of SEQ ID NO:68, as being a prostate cancer specific marker



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constitutes a pharmacological activity relevant to the asserted use as a diagnostic for prostate cancer, thus satisfying the utility requirement.

Withdrawal of these rejections under 35 U.S.C. § 101 and 112, first paragraph is therefore respectfully requested.

**VII. Rejection of Claims 1, 2, 4, 5 and 7-9 under 35 U.S.C. § 102(b)**

Claims 1, 2, 4, 5 and 7-9 have been rejected under 35 U.S.C. § 102(b) as being anticipated by WO 98/20129. The Examiner suggests that WO 98/20129 discloses cloning of a cDNA which has a region of about 87% identity with SEQ ID NO:68 across a portion of about 30% of SEQ ID NO:68. Thus, the Examiner suggests that the nucleic acid taught by WO 98/20129 cannot be distinguished from the instant invention because it would be expected to selectively hybridize to SEQ ID NO:68 and has at least 60% identity to SEQ ID NO:68. Further, the Examiner suggests that the WO 98/20129 sequence is a cDNA and is human and that this reference further teaches a vector comprising the cDNA, a host cell comprising the vector, and expression of the encoded protein using the host cell.

Applicants respectfully traverse this rejection.

As discussed in Section V, *supra*, parts (c) and (d) of claim

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1 of the instant application have been amended and are now drawn to a nucleic acid sequence hybridizing under stringent hybridization conditions of 50% formamide/6X SSC at 42°C for at least 10 hours or 6X SSC at 68°C without formamide for at least 10 hours to the nucleic acid molecule of (a) or (b) or a nucleic acid molecule having at least 90% sequence identity to the nucleic acid molecule of (a) or (b). Support for these amendments is provided in the specification at page 14, line 17 through page 16, line 30, and page 33, lines 3 through 5.

The sequence of WO 98/20198, with only 87% sequence identity over a portion of only 30% of the nucleotide sequence does not meet the limitations of the claims as amended.

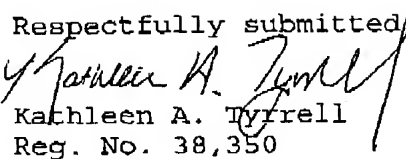
Thus, withdrawal of this rejection under 35 U.S.C. § 102(b) is respectfully requested.

#### VIII. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending

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claims is earnestly solicited.

Respectfully submitted  
  
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Date: March 15, 2004

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